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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 09/720,257   | 01/09/2001  | Wofgang Gunther      | 201013US0PCT                 | 8345             |
| 22850  | 7590        | 10/02/2006           | EXAMINER<br>TOOMER, CEPHIA D |                  |
| C. IRVIN MCCLELLAND<br>OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | ART UNIT<br>1714             | PAPER NUMBER     |

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/720,257 | <b>Applicant(s)</b><br>GUNTHER ET AL. |  |
|                              | <b>Examiner</b><br>Cephia D. Toomer  | <b>Art Unit</b><br>1714               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 14,16,17 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14,16,17 and 19-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 13, 2006 has been entered.

This Office action is in response to the amendment filed July 13, 2006 in which claims 14, 16 and 17 were amended and claims 19-24 were added.

***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 14, 16, 17 and 19-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

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claims 1-7, 9, 10 and 12-13 are of copending Application No. 10/505,767. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present invention are not as broad with respect to the propoxylate additive and the amine detergent. Therefore, the species of the present invention anticipate the genus of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 14, 16, 17 and 19-24 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 704519 with US 6,579,329 (Thomas) as the English translation.

EP teaches a fuel composition for internal combustion engine comprising a major amount of liquid hydrocarbon fuel and a (i) polyether additive and hydrocarbon polymer. The polyether is based on propylene oxide units wherein n is 8-30 and isotridecanol (see also col. 3, lines 15-25). The additive mixture further includes a (ii) polyisobutylamine detergent additive having a molecular weight of 500-1000 (see col. 2, lines 51-54 and Examples). The ratio of (i) and hydrocarbon polymer and (ii) is 5:95 to 85:15, preferably 20:80 to 80:20 (see col. 3, lines 54-56). The individual proportion of (i)

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and (ii) is 10-5000 ppm fuel (see col. 4, lines 12-15). The additive is used as an intake valve cleaner additive for fuel composition in internal combustion engine (see col. 4, lines 36-41).

Accordingly, EP '519 teaching all the limitations of the claims anticipates the claims.

5. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that EP 704519 fails to disclose or suggest a method of improving the intake system effect of a fuel composition for internal combustion engines because EP relies upon a combination of carrier oils and the amine to reduce the average valve deposit to a level in the range of 10 to 20 mg/valve. Applicant argues that EP teaches inferior results when the carbohydrate polymer component is missing.

EP teaches that the amine may be combined with a carrier oil. EP teaches that carrier oils such as those of the present claims are within the scope of its invention. EP exemplifies the amines and polyether carrier oils. While EP does show a greater decrease in deposits with the presence of the polymeric component (B), this teaching does not take away from the fact that the decreased deposits are obtained in the absence of component B. With respect to the degree of reduction, Applicant's claims are devoid of such limitation. Accordingly, EP teaches the limitations of the claims.

Applicant argues that Dr. Schwahn's declaration is commensurate in scope with the claims. Applicant argues that significant improved effects are obtained when the proxylate component is in the range of around 14 to 17.

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Applicant's claims are directed to a polyether wherein R' may be a straight chain or branched chain C<sub>8</sub>-C<sub>18</sub> alkyl or alkenyl. Applicant's data show R' as a C<sub>13</sub> alkyl (tridecanol) with 15 moles of propoxylate. The claimed polyether reads on far more compounds than are exemplified. Applicant's claims and Applicant's examples are not commensurate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Cephia D. Toomer  
Primary Examiner  
Art Unit 1714

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